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IN THE

Supreme Court of the United States

OCTOBER TERM, 1957

No. 678

TECHNICAL TAPE CORPORATION,
Petitioner,

vs.

MINNESOTA MINING AND MANUFACTURING COMPANY,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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Foreword.

No one of the "Questions Presented" by the petition (p. 2-3) arises from the record in this case. Each question involves a false factual predicate, contrary to the concurring findings of both courts below; and, in a plurality of the questions, contrary to the findings of every other court in which the Drew patent has been litigated.

RESPONDENT'S STATEMENT OF THE CASE.

This case presents the ordinary, usual issues of a patent infringement action. A single patent, which expired October 31, 1956 is involved, *viz.* Drew No. 2,177,627, owned by respondent. Respondent's commercial product

made under the patent is known as "Scotch" brand cellophane tape. Petitioner's infringing product is known commercially as "Tuck" brand cellophane tape.

Petitioner stipulated facts as to the structure of its tape, sales thereof, etc., which clearly show infringement by it (Pet. 14a-15a).

The District Court (Pet. 31a) and the Court of Appeals (Pet. 1a) concurred in finding the patent valid and infringed, and in finding that it had not been misused. These decisions were not in conflict with any prior decision, but were in accord with the prior decisions on the same patent. (*Minnesota Mining & Mfg. Co.* v. *International Plastic Corp.*, DC ND Ill. 1945, 62 F. Supp. 34, affd. 7 Cir. 1947, 159 F. 2d 554; *Minnesota Mining & Mfg. Co.* v. *Pax Plastics Corp.*, DC ND Ill. 1946, 65 F. Supp. 303, affd. 7 Cir. 1947, 159 F. 2d 554; *Minnesota Mining & Mfg. Co.* v. *Neisner Bros. Inc.*, ND Ill., 101 F. Supp. 926 (1951) and 122 F. Supp. 752 (1954).

Every court that has ruled on the patent has not only held it valid but has paid special tribute to it. Infringement has always been found, and, as petitioner alleged in its complaint, by structures "substantially identical with or not materially different from" petitioner's tape (Pet. 14a footnote).

Petitioner's allegation of misuse of the patent and "unclean hands" in the instant case was also rejected, both by the District Court (Pet. 49a-50a) and by the Court of Appeals (Pet. 17a-30a).

Before the courts below, on the "misuse" and "unclean hands" defenses*, petitioner cited Section 3 of the Clay-

* The "misuse" pleaded by plaintiff in its reply to the counterclaim is set forth in footnote 6 of the Court of Appeals opinion (Pet. 17a).

ton Act (15 U.S.C., Sec. 14). That is the only section of the anti-trust laws which petitioner has heretofore contended was violated by respondent. The Court of Appeals rejected such defense, saying (Pet. 28a-29a):

> "And there is no proof that defendant violated Section 3 of the Clayton Act (15 USC Sec. 14). In fact the proof is to the contrary. The defense of 'misuse' by defendant of its Drew II patent, appears to be something that plaintiff sought in vain to construct, in order to escape the consequences of its own deliberate and profitable infringement."

Here petitioner shifts to a citation of Section 13(e) of 15 U. S. Code (an amendment of the Clayton Act by the Robinson-Patman Act), apparently abandoning its earlier charge of violation of Section 14 of 15 U. S. Code. Petitioner cites no record support for its charge that respondent violated Section 13(e) of 15 U. S. Code, and its assertions have no basis in the record. As in the courts below, petitioner seizes upon the vehicle of alleged misuse by respondent "in order to escape its own deliberate and profitable infringement" (Pet. 29a), but this time with reliance on a different section of the statutes.

The petitioner incorporates in each of its questions factual postulates which are not supported by the record, and which are opposed to the concurring findings of the District Court and the Court of Appeals. Also it asks this Court to rule *for the first time* on questions not raised by it before the courts below.

THE "QUESTIONS PRESENTED" DO NOT ARISE.

Question 1.

Question 1 presupposes "Agreements with wholesalers (dealing in both its (respondent's) patented and unpatented tapes) to sell the patent owner's tapes *exclusively*"

(italics are petitioner's, Pet. 2). There was no such agreement, and even the so-called "select" distributors "did not carry 3M tapes exclusively" (Pet. 27a, *footnote*, last two lines; also see generally Court of Appeals opinion, Pet. 26a-27a, and District Court opinion, Pet. 50a).

Petitioner asserts (Pet. 4-5) that respondent sought exclusive dealing agreements with several wholesalers who "refused such agreements and Minnesota thereafter refused to supply them with any tapes at all". This assertion is contrary to the evidence and is contrary to the findings of the District Court (Pet. 50a) and of the Court of Appeals (Pet. 17a-24a). The seven distributors referred to by petitioner, and the facts in respect to each of them, are discussed fully by the Court of Appeals (Pet. 17a-30a). The District Court observed (Pet. 50a) that "3M distributes its products through upwards of 30,000 outlets" and that out of this "large number" in the "three year period preceding the trial Technical Tape points to seven" who "account for a relatively minutial portion of the total 3M tape business". None of those seven had ever been asked to deal exclusively in respondent's tapes and none was dropped because of failure to so deal.* The Court of Appeals summarized the evidence and the reasons that five of the seven distributors were dropped as follows:

> "A jobber who resorted to the disparagement of defendant's products in order to substitute other and cheaper brands of tape, including infringing brands of tape, where the customer wanted defendant's tapes; a jobber who did not deal fairly with defendant's products in displaying and selling them; a jobber who

* It is a considerable tribute to Minnesota's business integrity that Technical could find nothing more to champion than seven disgruntled distributors, combed out of more than 30,000.

> was more interested in pushing the sales of competitors' products to the detriment of defendant's products; a jobber with only a few customers, who made no effort to sell defendant's product; a jobber who failed so called 'drop shipment' orders to mislead the defendant and thus gain a larger discount; a jobber who was habitually delinquent in paying his bills—jobbers who did any of those things were not desirable distributors of defendant's products and defendant was not required to continue them as distributors." (Pet. 22a-23a)

Respondent's, 3M's, sales to distributors "were not made on any condition that the distributor deal only in 3M tape"; "distributors who purchased 3M tape also purchased tape from others"; "3M made no tie-in sales arrangement with its distributors"; and "no jobber was required to handle any one type of tape in order to purchase another" (Pet. 26a, *footnote*). "3M never had any policy of exclusive distributorship for a given territory" (Pet. 27a, *footnote*).

The record is barren of tie-in arrangements, exclusive distributorships, or disproportionate service among distributors.

Question 2.

Like Question 1, Question 2 (Pet. 2) does not emerge from the record. The petitioner refers to the Brandenberger French patent, which the District Court fully analyzed and found wanting as prior art (Pet. 40a-43a). The Court of Appeals affirmed (Pet. 10a). In a footnote the Court of Appeals (Pet. 10a) merely called attention to the fact that its determination of affirmance coincided with the view of the Court of Appeals of the Seventh Circuit, to the effect that a similar United States Brandenberger patent "did not in any way anticipate the disclosures" of Drew.

This is not undue procedure on the part of the court, as petitioner implies (Br. 14-15)*, but rather diligence.

Question 3.

Question 3 (Pet. 2) likewise presumes a fact not true. The respondent made no "concessions that its patented combination was old" and did not concede that it "was disclosed in a prior art patent".

In opposing a certain Rado application in Germany, the respondent asserted that Rado's disclosure was like the French Brandenberger patent and could not be amended after "Scotch" brand cellophane tape was on the market in Germany to convert the Rado application into a disclosure which would include respondent's pressure-sensitive cellophane tape (DA 275a-281a). There were no concessions and no admissions against interest (Pet. 43a).

Question 4.

This question is based upon a distortion of the facts, as shown by the decision of the District Court (Pet. 33a-37a) and that of the Court of Appeals (Pet. 8a-10a). The combination of elements in the patented tape "cooperates with each other so as to produce a new and useful result", a "new article", which "contributed something not had before" (Pet. 8a). This meets the test of *A. & P. v. Supermarket*, 340 U.S. 147. The "conjunction or concert of known elements * * * exceeds the sum of its parts" (340 U.S. 152).

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* Petitioner says that the Court of Appeals "somehow obtained a brief Minnesota had filed in the 7th Circuit" (Pet. 14), implying that there is something mysterious about how the Court found a copy available. While we do not know, we would suppose that the Court asked the Clerk of the Seventh Circuit to send it a copy, or else referred to a copy in one of the libraries where they can be found.

As the District Court said: "It may be that Drew employed a backing with non-fibrous surfaces contrary to the precepts of the art precisely because he was 'more of a cook than a chemist'. That a person having ordinary skill in the art would 'know better' than to attempt it does not negative patentability" (Pet. 36a-37a).

The patentee of one of the prior patents (Brandenberger), heavily relied upon by plaintiff, "failed to discern in his own patent what plaintiff's expert now claims was apparent to anyone ordinarily skilled in the art" (Pet. 42a).

The aggregation argument was first raised in the *International* case (cited *supra*) and was rejected there. It has been raised and rejected several times since, with no dissents. It is not a question to occupy the energies of this Court.

Question 5.

This question presupposes that the holding of infringement depends on an application of the doctrine of equivalents. This is incorrect. Claims of the Drew patent in suit, directed to transparent tape, of which claim 4 (Pet. 7a, *footnote*) is illustrative, are literally infringed by the transparent "Tuck" cellophane tape*, whether made with a rubber-resin adhesive (Pet. 14a, *footnote*; paragraph 5 of the Agreed Statement) or with "a polyvinyl ether rather than rubber and resin" (paragraph 9 of the Agreed Statement, Pet. 14a, *footnote*).

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* "If accused matter falls clearly within the claim, infringement is made out and that is the end of it." **Graver v. Linde**, 339 U. S. 605, 607 (1950).

So long as there is literal infringement by both types of tape of such typical claims as 4 and 10 (Pet. 7a), it is unnecessary to determine whether resort to the doctrine of equivalents is necessary to find infringement of some other claim (Pet. 52a).

Hence, like Questions 1, 2, 3 and 4, Question 5 does not emerge from this record.

ARGUMENT.

From "Respondent's Statement of the Case", above, it is shown that none of the "Questions Presented" (Pet. 2-3) has a factual foundation in the record. Even by incorporating into the questions facts which do not exist and assumptions contrary to fact, the petition would raise merely settled points of law recognized by the courts. None require any further elucidation. Even were this not so, the present action presents no occasion for discussion of those questions because none arise from the facts proved and found herein.

Even on the assumption that the record supports the questions, there is no diversity of opinion between circuits as to either the validity or infringement (by substantially identical structures) of the Drew patent in suit; there is no conflict with any decision of this Court*; there has been no departure from established judicial procedure; there is no question of public importance to be resolved.

The only parties in interest are private litigants. The sole remaining question in the case is the amount of damages for the "wilful", "deliberate" (Pet. 16a-17a) infringement of a patent which expired over a year ago.

To escape its premeditated infringement, petitioner charged misuse of the patent. The District Court found that respondent did not misuse its patent. Petitioner ignores the affirmance of the trial court's findings by the Court of Appeals. Likewise petitioner ignores the provisions of F.R.C.P. 52(a), which Rule has greater application because of the concurrence in fact finding of the

* Petitioner attempts to show a conflict in respect to the doctrine of equivalents, but such doctrine is not involved, for there is literal infringement, as shown, hereinbefore.

courts below. (See *Graver* v. *Linde*, 339 U.S. 605, 609-610).

The petitioner argues (pp. 4-5, 9-10) that the Court of Appeals has decided a question of law relating to misuse of patents in conflict with decisions of this Court and those of other circuits. The Court of Appeals did not so decide. It recognized the law applied in the cases to which the Petition refers (it cited two of the four cases relied upon in the Petition), but found the facts here to be contrary to petitioner's contentions.

The District Court found (Pet. 50a) that respondent's sales efforts were "motivated solely by honest business considerations in no way related to an attempt to extend the Drew patent". This statement is equally true in respect to the present emphasis on alleged misuse, that is, disproportionate service among jobbers (15 USC 13c) rather than tie-ins, restrictions, and exclusive arrangements (15 USC 14) previously urged.

There was no showing that disproportionate services were afforded to any of the industrial distributors. Moreover, respondent sells many tapes for industrial uses,—the patented tape here involved contributes but a minor part of such sales (R. 3874-6). Even had there been any disproportionate furnishing of services in the training of salesmen, suggestions as to possible uses for various tapes, suggestions as to how such tapes could be most efficiently applied, etc.,—none was shown—still such would not have had any significant relationship to the patent in suit and would constitute neither use nor misuse of the patent.

Petitioner's argument of disproportionate services not only is unsupported by the evidence, but there is not shown to have been any connection or relationship to the patent, even assuming the existence of disproportionate

services. Both Courts below held that no showing of misuse or unclean hands had been made.*

The foregoing discussion relates to Question 1. The remainder of the five questions relate only to the validity and scope of a now expired patent.

Question 2 does not exist, for the very sound reason that the Court of Appeals stated adequate grounds, in affirmance of the District Court, that the Brandenberger patent is not anticipatory. (C.A. 2 Opinion, Pet. 10a; D.C. Opinion 40a-43a). It was not a denial of due process (Pet. 2) for the Court of Appeals to compare its conclusion in respect to Brandenberger with the decision of a coordinate court on a related matter.

Here, again, all reasons for certiorari fail.

Question 3 answers itself. If, as a fact, the patented combination was old, and respondent had so conceded, that would have ended the matter. But, as shown in respondent's statement of the case, and as found by the Courts below, such concession was not made (Pet. 43a). The question does not arise from the record, and furnishes no basis for the writ.

In Question 3, respondent's invention is referred to as a "patented combination" (Pet. 2). In Question 4, the same patent is charged to be an aggregation. But the very

* Petitioner's contention of unclean hands against respondent takes on a rather ludicrous flavor when it is noted, as the Court of Appeals has held (Pet. 16a), that petitioner, in perpetrating its "willful" and "deliberate" infringement, "persuaded an employee of Minnesota's (a quality control man) in May 1951 to get Minnesota's 'standard books' and advised him to keep from his employer the fact that he was to enter plaintiff's employ."

case cited in the question (*A & P* v. *Supermarket*, 340 U.S. 147) at page 152 defines the invention as a true combination, as both courts below found,—"a combination of old elements which cooperate with each other so as to produce a new and useful result" (C.A. Pet. 8a, citing *A & P* v. *Supermarket*).

There is concurrence with the views expressed by this Court in the *A & P* case; not dissent from them. Hence no reason exists for the writ in respect to Question 4.

Question 5 does not arise from the record. The petitioner declared in its complaint that its tape was "substantially identical with or not materially different from" those previously adjudicated infringements (Pet. 14a, footnote).

Judge Campbell, Judge Bicks, and the Court of Appeals, by its affirmance, held, in respect to the accused synthetic polymer tape, that the polymer was "rubbery" to satisfy claims 5, 6, and 7; that it was "rubber-resin type", as required by claim 8; and that such typical claims as 4, 10, and 15 find response in their requirement of "water-insoluble normally tacky and pressure-sensitive transparent adhesive coating" (Pet. 48a).

Thus, literal infringement was found in respect to the so-called synthetic polymer tape.

No question is here raised about literal infringement by the rubber-resin tape of petitioner.

"If accused matter falls clearly within the claim, infringement is made out and that is the end of it."—*Graver* v. *Linde*, 339 U.S. 605, 607. See also the *Paper Bag case* 210 U.S. 405, 419; and *Smith* v. *Snow*, 294 U.S. 1, 11.

When the accused matter falls clearly within some of the claims in suit, it is academic to inquire whether it necessarily falls within one or more other claims in suit, under the doctrine of equivalents.

Hence Question 5 does not arise. There is no reason to issue the writ to debate academic questions which would not change the ultimate result.

Throughout its petition petitioner makes a number of oblique attacks on the invention of the patent in suit. It makes no attempt to explain why it is that the courts have consistently disagreed with it. Each of the nine Federal judges who have considered the Drew patent have found it valid and have paid tribute to it. Petitioner's assertions are made without record support, and are in the nature of half truths and unfair innuendoes. For example, petitioner implies that any "sticky adhesive" is a "normally tacky and pressure-sensitive adhesive", within the meaning of the Drew patent, which is wholly inaccurate.

Again, it is implied that the patent in suit differs from the subject matter of an earlier Drew patent only in that cellophane is substituted for paper. Again, this is inaccurate, and it ignores or overlooks the fact that the production of a self-adhering packaging tape using a film backing involved many problems and departed completely from the dogma of the prior art, which had always followed the principle of a mechanical interlock of the adhesive (when in the wet state) with the fibers of cloth and paper backings.

For a much fairer characterization of what Drew did, we refer to the opinion of the District Court (Pet. 34a-37a) and to its affirmance by the Court of Appeals (Pet. 8a *et seq.*). Also we refer to the decision of the Court of

Appeals, 7th Circuit, in *Minnesota* v. *International*, 159 F. 2d 554, 556 (col. 2). Also see the decision of Judge Barnes in *Minnesota* v. *Pax Plastics*, 65 F. Supp. 303, 308 (parag. 22). These decisions span a period of more than ten years, in respect to an important patent, now expired.

Petitioner refers to the patent in suit as an "incredible patent". This is a grotesque characterization in view of the extensive and unanimously favorable judicial review this patent has had.

CONCLUSION.

For the reasons stated the writ should be denied.

Respectfully submitted.

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